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| 09/804,613      | 03/12/2001  | Richard M. Ozanich   | P-1259-011          | 3155             |

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Floyd E. Ivey  
Liebler, Ivey & Connor  
P.O. Box 6125  
Kennewick, WA 99336

EXAMINER

EVANS, FANNIE L

ART UNIT PAPER NUMBER

2877

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/804,613

Applicant(s)

OZANICH, RICHARD M.

Examiner

F. L. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *The Specification*

Under the heading "Continuation In Part Application" on page 1, the third-seventh sentences, "New matter herein...with claim 22.", should be cancelled.

Lines 8 and 9 should be cancelled from page 7. An information disclosures statement is not in the file wrapper of this application.

The brief descriptions of Figs. 1, 1D-1F, 2, 2B, 3, 3A, 3B, 4, 5, 5B-D, 6, 6B, 6C, 7, 7C, 8, 9 and 11 of the drawings are too long. Correction is required.

Lines 1-4 should be cancelled from page 55.

The brief descriptions of Figs. 9-15A (pages 55-57) must not be separated from the brief descriptions of claims 1-8A (pages 11-21).

The detailed description on pages 57-67 must not be separated from the detailed description on pages 22-54.

The underlining on pages 55-57, 59, 63, 64, 65 and 66 must be deleted.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### Arrangement of the Specification

As provided in 37 CFR § 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase

"Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### *Claim Objections*

The numbering of claims is not in accordance with 37 CFR § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 9A-41 have been renumbered 10-64.

In line 2 of claim 11, "is a" should be deleted because it is redundant. Claims 9, 25, 27,

30, 31, 33, 36, 44, 46-50, 53, 55, 59-61, 63 and 64 are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

All of the claims contain a period after each of the capitalized alphas. Claims 30 and 36 contain multiple sentences. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations.

Claim 50 makes reference to certain figures of the drawings. The claims are to be complete in themselves. Incorporation by reference to specific figures in exceptional circumstances. See MPEP 2173.05(s).

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-64 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is incomplete in that it fails to set forth a connection between the algorithms built and the sample characteristics calculated. Claims 2-6, 24-30, 37-45, 47, 48, 51-57 and 59-64 inherit the problem of claim 1 through dependency.

The lack of an antecedent for "the VIS and NIR spectra" in line 3 of claim 2; "sampling" in line 2 of claim 6; "the correlation analysis" in line 6 of claim 6; "the light detector fiber" in line 4 of claim 7; "The apparatus of claim 7" in line 1 of claim 9; "the at least one illumination source" in line 3 of claim 9, in line 2 of claims 12, 19 and bridging lines 2 and 3 of claim 20; "the at least one mechanism of measuring the illumination" in line 5 of claim 9; "the at least one light detector" in line 7 of claim 9 and bridging lines 4 and 5 of claim 21; "the plurality of illumination fibers" in line 2 of claim 14; "the plurality of illumination sources" in line 2 of claim 16; "the at least one light detector" in line 4 of claim 16; "the plurality of light detectors" in line 2 of claims 17 and 18; "the plurality of illumination fibers" in line 3 of claim 19; "the polarization filter" in line 2 of claim 22 and "the matching polarization filter" bridging lines 2 and 3 of claim 22 renders these claims and any claim dependent therefrom indefinite.

Claims 8 and 23 are directed to an apparatus for performing the method of claim 1. However, the claims fail to set forth means/structure for building algorithms and calculating the characteristics of a sample. The claims that depend from claims 8 and 23 inherit the problems of the independent claims.

Claim 9 and the claims that depend therefrom are incomplete and indefinite. The preamble of claim 9 sets forth an apparatus and claim 9 depends from claim 7. Claim 7 is not directed to an apparatus but rather it is directed to a method.

Claim 11 and the claims depend therefrom appear to be incomplete in that claim 10 does not end with a period.

Claim 13 contradicts claim 11. Claim 11 specifies that the at least one illumination

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source is a tungsten halogen lamp. Dependent claim 13 specifies that the at least one illumination comprises a plurality of illumination fibers.

Claim 15 contradicts claim 12. Claim 12 specifies that the at least one illumination source is an illumination fiber. Dependent claim 15 specifies that the illumination source is a 5w tungsten halogen lamp.

Claim 19 contradicts claim 12. Claim 12 specifies that the at least one illumination source is an illumination fiber. Dependent claim 19 specifies that the illumination source is comprised of an ellipsoidal reflector with a 5w tungsten halogen lamp and a cooling fan..

Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 9, 30, 36, 43, 50, 54, 55, 59 and 63, the phrase "for example" and "e.g." renders the claims indefinite because it is unclear whether the limitation following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 50, reference to "those of ordinary skill in the art" must be deleted.

Regarding claim 54, reference to "common to the art" and "common to other industries" must be deleted.

The claims are narrative replete with indefinite language. The method must be set forth in active steps, in operative sequence for an end result. The structure which goes to make up the apparatus must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4 and 8 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Strobl et al (US 5,303,026).

Strobl et al disclose (1) a method of determining characteristics of samples comprising the steps of claims 1 and 4 and (2) an apparatus set forth in the body of claim 8. Applicant's attention is directed to Strobl et al in its entirety with particular attention directed to lines 16-20 in column 3, lines 20-41 and 45-50 in column 5 and lines 61-63 in column 6.

Claims 1, 4, 5 and 8 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Jung et al (US 5,926,262).

Jung et al disclose (1) a method of determining characteristics of samples comprising the steps of claims 1, 4 and 5 and (2) an apparatus set forth in the body of claim 8. Applicant's attention is directed to Jung et al in its entirety with particular attention directed to lines 22-67 in column 35, lines 1-21 in column 36 and lines 38-49 in column 37.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or



improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, respectively, of U.S. Patent No. 6,512,577 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application.

#### ***Fax/Telephone Numbers***

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax numbers for Technology Center 2800 are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

If applicant wishes to send a fax containing a Proposed Amendment for discussion during either a personal interview or a telephone interview then the fax should:

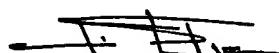
- 1) Contain either the statement "**DRAFT**" or "**PROPOSED AMENDMENT**" on the Fax Cover Sheet; and
- 2) Should be unsigned by the attorney or agent.

This will ensure that the amendment will not be entered into the application and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (703) 308-4805. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font, can be reached on (703) 308-4881. The TC Receptionist's telephone number is (703) 308-0956.

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Any other inquiry of a technical nature, and all inquiries of a general nature including those relating to the status of an application should be directed to TC 2800 Customer Service Office whose telephone number is (703) 306-3329.

  
**F. L. EVANS**  
**PRIMARY EXAMINER**  
**ART UNIT 2877**

file  
May 30, 2003